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| 10/551,239 | 09/28/2005 | Harald Schwahn | 278349US0PCT | 4258 |

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| EXAMINER |
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HINES, LATOSHA D

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| ART UNIT | PAPER NUMBER |
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1797

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08/06/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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| Office Action Summary | Application No. 10/551,239 | Applicant(s) SCHWAHN ET AL. | |
| | Examiner LATOSHA HINES | Art Unit 1797 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 21-44 are pending. Claims 42-44 are new.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 44 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a NEW MATTER rejection. In new claim 44, applicant claimed "the additive does not comprise a carrier oil". Applicant did not state in their remarks where this claim language could be found. However, the specification only gives various examples and teachings of "carrier oils".

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 21-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over ABRAMO et al. (US 5,089,028) in view of SCHWAHN et al. (US 2003/0140552).

ABRAMO et al. discloses a gasoline additive which can be used in a minor effective amount as a carburetor, port fuel injector and in-take valve cleanliness additive which limits the amount of deposit formation. The components of the additive synergistically clean the fuel system of a spark ignition internal combustion engine, column 1 lines 30-47. The additive contains polyalkenyl succinimide which is the reaction product of a polyalkenyl succinic anhydride and a polyalkylene polyamine, column 1 lines 53-67. ABRAMO et al. discloses paraffins, olefins, aromatic hydrocarbons, or mixtures thereof. The fuel comprises up to 50 % alcohol or ethers, such as methanol and/or ethanol, column 5 lines 26-56.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to vary the alcohol amount to achieve a desired result. It is well-settled that optimizing a result effective variable is well within the expected ability of a person of ordinary skill in the subject art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). *In re Aller*, 220 F.2d 454, 105 USPQ 233 (CCPA 1955).

ABRAMO et al. does not explicitly or implicitly disclose various types of additives used in applicants' invention.

However, SCHWAHN et al. discloses an invention related to fuel additive compositions for internal combustion engines and to fuels that contain the corresponding additives for internal combustion engines (abstract).

The fuel additive compositions preferred according to the invention comprises: an alcohol preferably ethanol; additives containing groups derived from succinic with hydroxyl and/or amido and/or imido groups are preferably corresponding derivatives of polyisobutenyl succinic anhydride having a Mn of from 150 to 5000 (paragraph 0060); polyalkenemonoamines or polyalkenepolyamines or functional derivatives thereof which can be used according to SCHWAHN et al. are in particular poly-C2-C6-alkeneamines or functional derivatives thereof, for example based on polyethylene, polypropene, polybutene or polyisobutenes, or mixture thereof, having a Mn of 150 to 5000 (paragraph 0034 and 0036); additives containing groups produced by Mannich reaction of substituted phenols with aldehydes and mono- or polyamines (paragraph 0061); polyetheramines are poly-C2-C6-alkylene oxide amines and examples of polyalkeneamines are poly-C2-C6-alkene-amines, and functional derivatives thereof, in each case having a preferred Mn from about 150 to 5 000. SCHWAHN et al. has met the limitations of claim 21 and 25-28. Additives containing groups produced by Mannich reaction of substituted phenols with aldehydes and mono- or polyamines (paragraph 0061), meeting the limitations of claim 29.

The gasoline fuel may furthermore have an olefin content of not more than 21, e.g. from 6 to 21, % by volume (paragraph 0070). The benzene content may be not more than 1.0, e.g. from 0.5 to 1.0, % by volume; the oxygen content may be, for example, from 0.1 to 2.7% by weight (paragraph 0072). The fuel may be,

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for example, a gasoline fuel having aromatics content of not more than 42, e.g. from 20 to 42% by volume (paragraph 0069). The further fuel additives which may be used and which have the polar groups are added to the fuel usually in an amount of from 10 to 5000 ppm, in particular from 50 to 1000 ppm (paragraph 0068) and a sulfur content of not more than 150 ppm (paragraph 0069), meeting the limitations of claims 24 and 30-35.

SCHWAHN et al. discloses a fuel composition wherein all of the physical properties of the gasoline are present. In addition, a *prima facie* case of obviousness exists because the claimed ranges overlap or lie inside ranges disclosed by the prior art, see *In re Wertheim*, 541 F.2d 257, 191 USPQ 90. See MPEP 2131.03 and 2144.05.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the synergistic additives of SCHWAHN et al. in the fuel composition ABRAMO et al. in order to reduce in-take valve deposits in a gasoline engine.

A reference is good not only for what it teaches but also for what one of ordinary skill might reasonably infer from the teachings. *In re Opprecht* 12 USPQ 2d 1235, 1236 (CAFC 1989); *In re Bode* USPQ 12; *In re Lamberti* 192 USPQ 278; *In re Bozek* 163 USPQ 545,549 (CCPA 1969); *In re Van Mater* 144 USPQ 421; *In re Jacoby* 135 USPQ 317; *In re LeGrice* 133 USPQ 365; *In re Preda* 159 USPQ 342 (CCPA 1968). In addition, "A reference can be used for all it's

realistically teachings and is not limited to the disclosure in its preferred embodiments" See *In re Van Marter*, 144 USPQ 421.

Response to Arguments

6. Applicant's arguments filed May 24, 2010 have been fully considered but they are not persuasive.

a. Applicant argued Abramo teaches away from the present invention by not disclosing an ethanol amount of 55% to 75%, as claimed in the present invention. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to vary the alcohol amount to achieve a desired result. It is well-settled that optimizing a result effective variable is well within the expected ability of a person of ordinary skill in the subject art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). *In re Aller*, 220 F.2d 454, 105 USPQ 233 (CCPA 1955).

b. Applicant argued the additive of claim 43 is selected from the group "consisting of" polyisobutenamine, polyetheramine, a product obtained by Mannich conversion of substituted phenyl with aldehyde and amine, and combinations thereof. However, claim 43 depends upon claim 21, which is open-ended claim language, "comprising" allows for the addition of other additives to the composition such as those set forth in the prior art.

c. Applicant argued Abramo and Schwahn explicitly suggest improving the action of a detergent with specific carrier oil mixtures. Applicant has amended the present invention to include "no carrier oils". Applicant does not have support

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in the specification of the present invention to claim "no carrier oils". However, Abramo discloses in column 3, carrier fluids which comprise of esters and the carrier fluid can be less than 80 wt%. Abramo discloses "less than 80 wt%". For examination purposes, the examiner is interpreting the claim to encompass zero.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LATOSHA HINES whose telephone number is 571-270-5551. The examiner can normally be reached on Monday thru Thursday from 8 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Marcheschi can be reached on 571-272-1374. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/LATOSHA HINES/
Examiner, Art Unit 1797

/Ellen M McAvoy/
Primary Examiner, Art Unit 1797